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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/561,571	12/21/2005	Meng Hsin Chen	21406YP	5907				
210 MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907	7590 06/18/2008		<table border="1"><tr><td>EXAMINER</td></tr><tr><td>BALASUBRAMANIAN, VENKATARAMAN</td></tr></table>		EXAMINER	BALASUBRAMANIAN, VENKATARAMAN		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### **ADVISORY ACTION**

The applicants' response, which included cancellation of claims 1, 3-6, 8, 9 and 12-15 and addition of new claims 16-27, filed 5/2/2008 under 37 CFR 1.116 in reply to the final rejection is not entered as it is not deemed to place the application in condition for allowance for the following reasons.

#### ***Claim Rejections - 35 USC § 112***

Claims 17-27 will be rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. The newly added claims 17-20 and 22-27 are improper dependent claims as they are dependent on cancelled claims. Note these claims are dependent on claim 1, 2, 3, 5, 12 and 14

Applicants did not overcome the following 102 rejection made in the previous office action.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-6, 8 and 12-15 rejected under 35 U.S.C. 102 (b) as being anticipated by Yamasaki et al., US 6,352,985.

Yamasaki et al. teaches several benzimidazole compounds for treating glaucoma, which include those claimed in the instant claims. See column 2, formula I and note the definition of R<sub>1</sub>, R<sub>2</sub>, R<sub>3</sub>, and R<sub>4</sub> groups. Note with the given definition of these variable groups compounds taught by Yamasaki et al., include instant compounds. See column 2-19 for preferred embodiments and process of making these compounds. See column 29-39 and figure 1-58 for various species made. See also column 41-162 for examples 1-322.

This rejection is same as made in the previous office action. Applicants' amendment to R<sub>4</sub> and R<sub>5</sub> did not completely exclude compounds taught in this reference. Note cyano-benzimidazole is taught in this reference which is also embraced in the instant claims. See compound 52. In addition when R<sub>4</sub> or R<sub>5</sub> is substituted alkyl, the compounds taught by the reference are also claimed in the instant claims. See compounds 160-162.

Hence, this rejection is proper and is maintained.

***Allowable Subject Matter***

Claim 21(original claim 7) will be allowed, barring finding of any prior art in a subsequent search.

***Conclusion***

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is

James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

/Venkataraman Balasubramanian/

Primary Examiner, Art Unit 1624

